

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Final Office Action dated October 18, 2007. Claims 1-10, 23, and 27-28 are pending in the application. Claims 1, 4-5, 7-9, and 23 have been amended. New claims 29-32 have been added. No new matter is added by these claims. Claims 22 and 24-26 have been cancelled.

In the Office Action, claims 1-10, 23, 27 and 28 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. In addition, claims 1-20, 23, 27, and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wilson *et al.*, U.S. Patent No. 6,660,248 (“Wilson”) in view of Stahl *et al.*, U.S. Patent No. 5,470,843 (“Stahl”) or in view of Yan *et al.*, U.S. Patent No. 5,830,539 (“Yan”), and further in view of Lei *et al.*, U.S. Patent No. 6,777,445 (“Lei”). Applicants believe all pending claims are allowable over the art of record and respectfully request reconsideration and allowance of all claims.

I. Claim 4 complies with the written description requirement

The Examiner has rejected claim 4 under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. Specifically, the Examiner states that the Specification does not provide support for the limitation “two to eight linking molecules.” Applicants submit that the Specification provides support for such a limitation in paragraph [0015], which states “[o]ne preferred method for forming a fullerene-antibiotic conjugate can be generalized as including . . . the synthesis of a fullerene derivative containing *one or more* linkers.” (Emphasis added). In addition, paragraph [0047] of the Specification states “up to 8 malonate groups can be placed on C60.” Nevertheless, for the sake of expediting allowance of the claims, Applicants have amended claim 4 to recite “more than one linking molecule,” which Applicants believe is fully supported by paragraph [0015] of the Specification. Accordingly, Applicants submit that amended claim 4 fully complies with the written description requirement and respectfully request withdrawal of the rejection.

II. Claims 1-10, 23, 27 and 28 are definite

The Examiner has rejected claims 1-10, 23, 27, and 28 under 35 U.S.C. §112, second paragraph for being indefinite. In particular, the Examiner states that it is unclear as to what linking molecules would be acceptable because the Specification only provides for malonate or serinol, etc. According to the Manual of Patent Examining Procedure (MPEP), the baseline

inquiry as to indefiniteness is “whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.” MPEP §2171. In addition, “[b]readth of a claim is not to be equated with indefiniteness. MPEP §2173.04 (citing *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)).

Applicants submit that one of ordinary skill in the art would know what is meant by a “linking molecule.” In particular, paragraph [0015] teaches “attaching the linking molecule to a fullerene . . . and affixing the desired bioactive agent to the end(s) of the linking molecule.” Furthermore, paragraph [0015] teaches “these steps can be accomplished by forming a malonate *or other linking molecule*.” (Emphasis added). Plainly, one of ordinary skill in the art would know that the linking molecule “links” the fullerene to the antibiotic and, thus, would easily understand the metes and bounds of the claim. If anything, the fact that the Specification recites malonate, serinol, etc. as examples of linking molecules would only further define what an “acceptable” linking molecule would be to one of ordinary skill in the art. Therefore, Applicants believe the limitation “at least one linking molecule” is definite and respectfully request withdrawal of the rejection.

The Examiner also has rejected claim 8 as being indefinite for improper Markush claim formatting. In response, Applicants have amended claim 8 to properly reflect proper Markush claim formatting. In light of the above, Applicants believe the amendments and remarks address the Examiner’s concerns and respectfully request withdrawal of the rejections.

III. Claims 1-10, 23, and 27-28 are patentable over *Wilson* in view of *Stahl* and *Yan*, and further in view of *Lei*.

The Examiner has rejected claims 1-10, 23, and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over *Wilson* in view of *Stahl* and *Yan*, and further in view of *Lei*. Applicants respectfully submit that the Examiner has failed to make a case of obviousness in rejecting claims 1-10, 23, and 27-28 because *Wilson* cannot be cited as prior art.

The Examiner has cited *Wilson* as teaching a fullerene scaffold having an amide linker containing diagnostic agents. Applicants first assert that *Wilson* is not available as prior art under § 102(a) for the purposes of § 103(a) because invention of the subject matter occurred prior to the publication date of *Wilson* on November 7, 2002. To support the contention that *Wilson* is not available under §102(a), Applicants submit an affidavit under 37 CFR 1.131 stating

that invention took place prior to the effective publication date of November 7, 2002. In further support of Applicants' invention before *Wilson*'s publication date, Applicants have included the reference, Cubbage et al., Eighth Annual Orthopedic Resident Research Forum, vol. 8, 2002 ("*Cubbage*"), which has an effective date of May 30, 2002. In the § 1.132 affidavit submitted May 24, 2007, Applicants stated that *Cubbage* described Applicants' own work. As such, *Cubbage* clearly shows invention of the subject matter prior to the *Wilson* publication date. Therefore, *Wilson* is not available as prior art under § 102(a) for the purposes of § 103(a).

In the alternative, *Wilson* cannot be used as § 102(e) prior art for the purposes of § 103(a) because of the common ownership exception of 35 U.S.C. § 103(c). According to § 103(c):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that *Wilson* and the pending application are commonly owned by Rice University. Applicants further assert that the pending application and *Wilson* were commonly owned by Rice at the time the invention was made. As a result, Applicants submit that *Wilson* cannot be cited as prior art under § 103(a)/102(a) in view of the § 1.132 affidavit, or in the alternative, *Wilson* cannot be cited as prior art under § 103(a)/102(e) because of the common ownership exception of § 103(c).

Because *Wilson* is unavailable as prior art, Applicants submit that claims 1-10, 23, and 27-28 are patentable over *Wilson* in view of *Stahl* and *Yan*, and further in view of *Lei*., and respectfully request that the Examiner withdraw the § 103 rejections thereof.

IV. Conclusion

Applicants respectfully request reconsideration, allowance of the claims, as amended, and a timely Notice of Allowance be issued in this case. If the Examiner feels that a telephone conference would expedite the resolution of this case, the Examiner is respectfully requested to contact the undersigned.

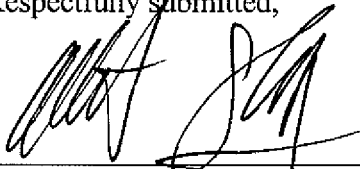
In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art that have yet to be raised, but which may be raised in the future.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769.

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